

Remarks

No amendments are made herein in reply to the final Office Action dated July 27, 2007. Claims 1-16 are pending in this application. Reconsideration of the Office Action is respectfully requested in view of the following remarks.

The Examiner has maintained the previous rejections in that claims 1-7 and 16 are rejected under 35 U.S.C. 103(a) over Berstis (US Pat. No. 6,721,001) in view of Endo (US Pat. No. 6,763,182) and Anderson (US Pat. No. 6,683,649), and claims 8-12 are rejected under 35 U.S.C. 103(a) over Berstis in view of Endo and Anderson, and further in view of Nakamura (US 2004/0019681). Claims 13-15, however, are again indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In reply to Applicant's Response filed July 6, 2007, the Examiner alleges that the previous rejection is proper because all of the rejected claims were rejected "under 35 U.S.C. 103(a) using references with a §102(e) date" and "the effective filing dates of the Bertis (December 16, 1998), Endo (March 30, 2000), Anderson (December 31, 1998), and Nakamura (July 17, 2003) references are prior to the instant application's effective filing date (September 22, 2003)" (emphasis added).

As the Examiner pointed out, when circumstances allow, a 103(a) rejection can be based on references with a §102(e) date. However, Applicant respectfully submits that the present 103(a) rejection based on 102(e) references is improper and not applicable to the present case as detailed herein below.

As noted in the Office Action, 35 U.S.C. §102(e) states that a person is entitled to a patent unless:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the

applicant for patent, or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent ... (emphasis added).

Under 35 U.S.C. §102(e), a later published U.S. patent application or a later issued patent as a reference must have the effective U.S. filing date earlier than the "the invention by the applicant for patent". Accordingly, the effective date of a 102(e) reference is the U.S. filing date, and the effective date of the present application of the applicant is the date of invention. It is well established that the applicant can rely on foreign priority under §119(a) to show an earlier date of invention which antedates the U.S. filing date of the application of the applicant. The present application was filed in the U.S. on September 18, 2003, with foreign priority claimed under §119(a) over Korean Patent Application 2002-57332 which was filed on September 19, 2002 in Korean Intellectual Property Office (receipt of certified copies of the priority documents acknowledged by the Patent Office). Therefore, the effective date of the present application for the consideration of 35 U.S.C. §102(e) is the foreign priority date of September 19, 2002, but not the U.S. filing date of September 18, 2003.

Accordingly, it is clear that, among the cited references, Nakamura (US 2004/0019681) is not a pertinent prior art reference under 35 U.S.C. 103(a)/102(e) because it has the effective U.S. filing date of July 17, 2003 which is later than the foreign priority date (i.e., September 19, 2002) of the present application. Therefore, at least for this reason, the above stated rejection of **claims 8-12** under 35 U.S.C. 103(a) citing Nakamura as a 102(e) reference is improper and should be withdrawn.

Applicant further submits that the rejection of **claims 1-7 and 16** under 35 U.S.C. 103(a)/102(e) over the combination of Berstis (US Pat. No. 6,721,001), Endo (US Pat. No. 6,763,182) and Anderson (US Pat. No. 6,683,649) is also improper at least because one of ordinary skill in the art cannot combine the teachings of these

references due to the fact that none of the references of Bertis, Endo, and Anderson were published or patented before the established date of invention (i.e., the foreign priority date) of the present application, namely, September 19, 2002. In this regard, Applicant notes that the earliest date of either publication or patent issuance of Bertis, Endo, and Anderson is April 13, 2003, July 13, 2004, and January 27, 2004, respectively, all of which dates are later than September 19, 2002. See the detail information of the U.S. filing dates, patent issue dates, and publication dates (if any) of the references on page 3 of Applicant's previous response.

Before a patent application is published, the records of a patent application are kept in secrecy and not open to the general public. Therefore, no one except the examiners (including employees of any of the three assignee corporations) can have access to all of these three references in order to combine the teachings thereof to reach the present invention as claimed. The prosecution records of the references clearly indicate that Bertis, Endo, and Anderson were assigned to different entities, namely, International Business Machines Corporation, Sony Corporation, and FlashPoint Technology, Inc., respectively. Hence, a person of ordinary skill in the art (even any employee of one of these corporations who may in certain occasions have access to the contents of the patent application which is particularly assigned to their own corporation) cannot look at the relevant teachings contained in all of these three references.

Therefore, without having access to the references, one of ordinary skill in the art can neither combine the teachings of such references nor have any motivation to do so. Accordingly, the rejection of **claims 1-7 and 16** under 35 U.S.C. 103(a) (based on all later published or patented 102(e) references) over the combination of Bertis, Endo, and Anderson is improper and should be withdrawn. Accordingly, the above rejection of claims 1-7 and 16 under 35 U.S.C. 103(a) is improper and should be withdrawn.

In view of the foregoing remarks, Applicant respectfully submits that claims 1-16 of the present application are patentable and in condition for allowance. Favorable reconsideration and early notice to that effect is earnestly solicited.

Respectfully submitted,

A handwritten signature in cursive script that reads "A. J. Park".

September 24, 2007

Hyun Jong Park, Registration No. 59,093
Attorney for Applicants
TUCHMAN & PARK LLC
41 White Birch Road
Redding, CT 06896-2209
(203) 702-7102